**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

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| Applicants: | MERRIMAN, Dwight Allen et al. | | |
| Appl'n No.: | 10/798,342 | Group Art Unit: | 3627 |
| Filing Date: | 12 March 2004 | Examiner: | Laneau, Ronald |
| For: | METHOD OF DELIVERY, TARGETING, AND MEASURING ADVERTISING OVER NETWORKS | | |

**Mail Stop APPEAL BRIEF – PATENTS**
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

**APPEAL BRIEF UNDER 37 C.F.R. 41.37**

SIR:

This brief is in furtherance of the Notice of Appeal filed on September 19, 2005.

Appellants petition for a five-month extension of time extending the period of time in which to file a brief in support of an appeal up to and including April 19, 2006.

The Office is authorized to charge Kenyon & Kenyon LLP's Deposit Account No. 11-0600 the $500.00 fee for filing a brief in support of an appeal and the $2160.00 five-month extension of time fee. A duplicate of this page is provided for this purpose.

Although not believed necessary, the Office is hereby authorized to charge any additional fees required under 37 C.F.R. § 1.16, § 1.17 or § 41.20, or credit any overpayments to Deposit Account No. 11-0600.

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## I. REAL PARTY IN INTEREST

DoubleClick Inc. is the real party in interest for all issues related to this application by virtue of an assignment recorded with the Office at reel 008357, frame 0650.

## II. RELATED APPEALS AND INTERFERENCES

DoubleClick Inc. is also the real party in interest of the following:

A. Pending Appeals

Reissue application no. 09/577,798 is currently awaiting BPAI docketing. It is based upon U.S. Pat. No. 5,948,061, for which a Rule 607 Notice of Attempt to Provoke Interference was mailed on March 10, 2003.

B. Prior Appeals

Patent application no. 09/094,949 is allowed with a scheduled issued date of May 2, 2006 following a BPAI Decision On Appeal, mailed on February 7, 2005, reversing the Examiner's rejections.

## III. STATUS OF CLAIMS

Pending claims 1-22 stand finally rejected and are the subject of this appeal.

## IV. STATUS OF AMENDMENTS

No amendments were filed after the March 18, 2005 final Office action [hereinafter "Final Rejection"] in this application.

However, it is not clear from the record that the Office considered the Information Disclosure Statement ("IDS") and substitute form PTO-1449 filed on January 13, 2005. Applicants kindly request that the Office provide copies of the following January 13, 2005 IDS items, initialed by the Examiner to evidence their consideration, with the Office's next communication:

- 18 sheet substitute form PTO-1449
- IDS itself identifying:

- documents relating to a litigation (DoubleClick, Inc. v. L90, Inc., 00 Civ. 2690, S.D.N.Y.) involving U.S. Patent No. 5,948,061 (the '061 patent), which is associated with the same patent family as the present application, and
- two rule 1.132 inventor declarations that were filed in a pending reissue application based on the '061 patent (the declarations were attached as Exhibits to the January 13, 2005 IDS filing)

## V. SUMMARY OF CLAIMED SUBJECT MATTER

The subject matter defined in the sole independent claim on appeal (claim 1) is directed generally to a method of selecting an advertisement for delivery over a network such as the Internet. More particularly, the method of the present invention provides an efficient mechanism by which an advertisement can be targeted to a particular user based on stored information about the user.

FIG. 1 illustrates an embodiment of the invention as recited in independent claim 1, wherein an advertising server process (19) receives an advertisement request (23) from a user node (16), and selects, in response to the advertisement request (23), an advertisement based upon stored information about the user node (FIG. 3A). The advertisement request (23) is based upon a link sent (22) from an affiliate node (12) to the user node (16) in response to a content request (20) sent from the user node (16) to the affiliate node (12). This embodiment is described in the specification at least in paras. 17 and 21.

## VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

- whether claims 1-15 and 19-22 are anticipated under 35 U.S.C. §102(e) by U.S. Patent No. 5,960,409 to Wexler [hereinafter "Wexler"]
- whether claims 16-18 are unpatentable under 35 U.S.C. §103(a) over Wexler

## VII. ARGUMENT

The Final Rejection fails to demonstrate that Wexler anticipates any of claims 1-15 and 19-22 for at least the reasons that Wexler does not disclose:

- selecting an ad "based upon stored information about said user node" as recited in independent claim 1, and

- selecting an ad "in response to said advertisement request", wherein "said advertisement request is based upon a link sent from an affiliate node to said user node in response to a content request sent from said user node to said affiliate node" as recited in independent claim 1

The Final Rejection fails to render obvious any of claims 16-18 for at least the same reasons, and because the Examiner's Official notice of the rejection is based on the term "lookup tables", which is not mentioned in the claims or specification.

Details of these arguments are presented below.

A. Claims 1-15 and 19-22 Are Not Anticipated by Wexler

Independent claim 1 recites, in part, "selecting, in response to said advertisement request, an advertisement based upon stored information about said user node." Thus, in order for a prior art reference to anticipate this claim, it must show selecting an advertisement based upon stored user node information.

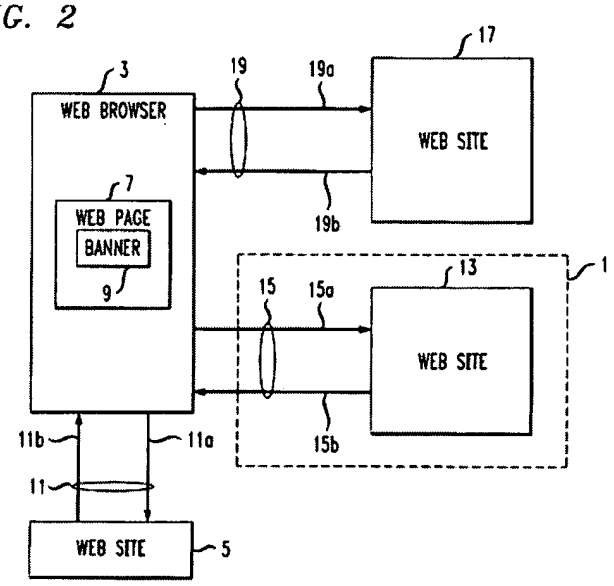
In the January 13, 2005 Response to Office Action, Applicants pointed out to the Examiner that the third party accounting and statistical system **1** of Wexler merely "accumulates and tabulates statistical information including the number of clicks on the advertiser's banner, and further provides data indicative of the effectiveness of the banner publisher's Web page as an advertising medium." Wexler, col. 2, lines 57-61. Since the third party system of Wexler only provides accounting and statistical information and does not select ads, it cannot anticipate independent claim 1 of the present application.

The Examiner in the Final Rejection effectively conceded Applicants' argument (i.e., that the third party system **1** of Wexler does not select ads) by contending that it is the user in Wexler who selects an ad as claimed by clicking on an ad banner. Final Rejection, p. 5, sec. 5.

Thus, the issue on appeal in connection with independent claim 1 is whether a user, who selects an ad by clicking on banner **9** in Wexler , anticipates independent claim 1. This clearly is not the case for at least the reasons that a user in Wexler clicking on a banner ad does not:

- select an ad "based upon stored information about said user node" as recited in independent claim 1, and
- select an ad "in response to said advertisement request", wherein "said advertisement request is based upon a link sent from an affiliate node to said user node in response to a content request sent from said user node to said affiliate node" as recited in independent claim 1

*FIG. 2*




As shown above in FIG. 2 of Wexler, a user visits web site **5** by directing its web browser **3** to request **11a** a web page **7** from the site, which in response downloads **11b** the web page **7** to the user's browser **3**. Note that the banner ad **9** is hard-coded into web page **7** prior to it being sent to the user (see Wexler, col. 4, lns 47-51). When the user clicks-through the ad **9**, instead of the ad **9** directing the browser **3** to the ad's associated web site **17**, it instead directs **15a** the browser **3** to the third party system **1**, which merely logs the click-through and redirects the browser's request (via **15b** and **19a**) to the ad's associated web site **17**. The ad's web site **17** then downloads **19b** its web page to the user's browser **3**, completing the user's click-through of banner **9**.

Nothing in the disclosure of Wexler teaches or suggests that a user selects an ad "based upon stored information about said user node" as recited in independent claim 1, and no teaching

or suggestion of the same was provided by the Examiner. All Wexler discloses is a user clicking on a banner ad **9** and awaiting a web page from the web site **17** associated with the ad **9**.

Similarly, nothing in the disclosure of Wexler teaches or suggests a user selecting an ad "in response to said advertisement request", wherein "said advertisement request is based upon a link sent from an affiliate node to said user node in response to a content request sent from said user node to said affiliate node" as recited in independent claim 1. As the above description of Wexler shows, the user receives a web page **7** from a web site **5** and clicks on a banner ad **9**. The user's clicking of the ad **9** is not in response to any type of advertisement request, nor an advertisement request based upon the elements recited in independent claim 1. Everything cited by the Examiner in Wexler occurs *after* the user clicks on the ad **9**.

Thus, it is impossible for either the user or the third party system **1** of Wexler (or any combination of the two) to anticipate independent claim 1, and accordingly its dependents 2-22, under this rejection.

B. Claims 16-18 Are Not Obvious

Regarding claims 16-18, these claims depend from independent claim 1, which, as explained above, cannot be anticipated by Wexler. Because the secondary arguments provided by the Examiner do not remedy the above-noted deficiencies of Wexler, these claims cannot be deemed obvious.

Additionally, in the Final Rejection in connection with the rejection of these claims, the Examiner takes Official notice that "to utilize a lookup table" is obvious because "it would increase flexibility of the system since arbitrary functions can be realized with lookup tables." Nowhere in claims 16-18, any other pending claim, nor in the specification is there any mention of "lookup tables". Thus, this rejection simply cannot stand.

## VIII. CONCLUSION

Appellants respectfully request that the Board of Patent Appeals and Interferences reverse the Examiner's decision rejecting claims 1-22 and direct the Examiner to pass the case to issue. These claims are allowable over the cited art.

Respectfully submitted,

Dated: April 19, 2006

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## CLAIMS APPENDIX

1. A method for advertising, comprising:

receiving an advertisement request from a user node, wherein said advertisement request is based upon a link sent from an affiliate node to said user node in response to a content request sent from said user node to said affiliate node; and

selecting, in response to said advertisement request, an advertisement based upon stored information about said user node.

2. The method of claim 1, wherein said stored information is based upon a prior content request sent from said user node to an affiliate node.

3. The method of claim 1, wherein said stored information is based upon a prior selection of an advertisement for said user node.

4. The method of claim 1, wherein said stored information is based upon a prior advertisement request from said user node.

5. The method of claim 1, wherein said stored information includes information in a cookie associated with said user node.

6. The method of claim 1, wherein the stored information includes at least one of the network address of said user node, the domain type of said user node, the time zone of said user node, the geographical location of said user node, and an industry code.

7. The method of claim 1, wherein said stored information includes the number of times an advertisement has been sent to said user node.

8. The method of claim 1, wherein selecting an advertisement is further based upon at least one of a browser type, a browser version, an operating system type, and a proxy server, each associated with said user node.

9. The method of claim 1, wherein said advertisement is selected if selection criteria associated with said advertisement are satisfied based upon said stored information.

10. The method of claim 1, wherein if selection criteria associated with more than one advertisement are satisfied based upon said stored information, then calculating a satisfaction index for each advertisement, and selecting the advertisement with the lowest satisfaction index.

11. The method of claim 10, wherein said satisfaction index for an advertisement is directly proportional to the number of times said advertisement is sent to a user node.

12. The method of claim 10, wherein said satisfaction index for an advertisement is inversely proportional to the amount of time expired since said advertisement was first permitted to be sent to a user node.

13. The method of claim 10, wherein said satisfaction index for an advertisement is inversely proportional to the maximum number of times the advertisement is permitted to be sent to a user node.

14. The method of claim 10, wherein said satisfaction index for an advertisement is directly proportional to the total amount of time over which said advertisement is permitted to be sent.

15. The method of claim 1, wherein said advertisement request includes an Internet Protocol address associated with said user node.

16. The method of claim 15, further comprising performing a reverse domain name lookup based upon said Internet Protocol address, and selecting said advertisement based upon the results of said reverse domain name lookup.

17. The method of claim 16, wherein said reverse domain name lookup includes a whois search.

18. The method of claim 16, further comprising performing a trace route operation, and selecting said advertisement based upon the results of said trace route operation.

19. The method of claim 1, further comprising sending said selected advertisement to said user node for display.

20. The method of claim 19, further comprising receiving from said user node a click through request for information about the advertiser associated with said selected advertisement.

21. The method of claim 20, further comprising sending a network address for said advertiser to said user node in response to said click-though request.

22. The method of claim 20, wherein said stored information includes information about a prior click-through request received from said user node.

## EVIDENCE APPENDIX

None.

## RELATED PROCEEDINGS APPENDIX

**Exhibit A**

BPAI Decision On Appeal, mailed February 7, 2005, reversing the Examiner's rejections in U.S. patent application no. 09/094,949.

Paper No. 29



UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DWIGHT A. MERRIMAN and KEVIN O'CONNOR

Appeal No. 2004-1828
Application No. 09/094,949[1]

ON BRIEF

Before GROSS, SAADAT and MACDONALD, Administrative Patent Judges.
SAADAT, Administrative Patent Judge.

## DECISION ON APPEAL

This is a decision on appeal from the Examiner's final rejection of claims 85-100. Claims 1-84 have been canceled.

We reverse.

## BACKGROUND

Appellants' invention is directed to automated selection of direct advertisements that correlate with particular users and groups of users of media. According to Appellants, when Internet users make a transaction or click on a direct advertisement, such

[1] Application for patent filed June 15, 1998, which claims the filing priority benefit under 35 U.S.C. § 119 of Provisional Applications No. 60/048,940, filed June 16, 1997 and No. 60/049,877, filed June 17, 1997.

as an advertisement banner, their browsers are redirected to an advertiser's server to respond to the user's request (specification, page 25). The advertiser's server responds by transmitting the requested information as well as some additional relevant information to be displayed by the user's browser (specification, pages 25 & 26). An understanding of the invention can be derived from a reading of exemplary independent claim 85, which is reproduced as follows:

> 85. A method for advertisement selection, comprising:
>
> (a) receiving from an advertiser Web site feedback representing user transactions at the advertiser Web site, the user transactions resulting from user response to at least one of a plurality of direct advertisements;
>
> (b) receiving a request to display a direct advertisement to a user; and
>
> (c) selecting, in response to the request, one of the plurality of direct advertisements for display based at least in part upon the advertiser feedback.

The Examiner relies on the following references:

Frank V. Cespedes et al. (Cespedes), "Database Marketing: New Rules for Policy and Practice," Sloan Management Reviews, Summer 1993, pp. 7-22.

Youji Kohda et al. (Kohda), "Ubiquitous advertising on the WWW: Merging advertisement on the browser," Computer Networks and ISDN Systems, Vol. 28, 1996, pp. 1493-1499.

Bill Harvey (Harvey), "The Expanded ARF Model: Bridge to the Accountable Advertising Future," Journal of Advertising Research, March/April 1997, pp. 11-20.

"Microsoft Press Computer Dictionary" (Microsoft Dictionary), Third edition, 1997, p. 387.

Claims 85-88, 90-93, 95-98 and 100 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Kohda and Cespedes.

Claims 89, 94 and 99 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Kohda and Cespedes and further in view of Microsoft Dictionary.

Claims 85-88, 90-93, 95-98 and 100 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Kohda and Harvey.

Claims 89, 94 and 99 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Kohda and Harvey and further in view of Microsoft Dictionary.

We make reference to the answer (Paper No. 25, mailed October 24, 2003) for the Examiner's reasoning and to the appeal brief (Paper No. 24, filed June 27, 2003) and to the reply brief (Paper No. 26, filed December 24, 2003) for Appellants' arguments thereagainst.

OPINION

We initially note that in rejecting claims under 35 U.S.C. § 103, the Examiner bears the initial burden of presenting a prima facie case of obviousness. See In re Rijckaert, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993). Furthermore, in considering the question of the obviousness of the claimed

invention in view of the prior art relied upon, the Examiner is expected to make the factual determination set forth in Graham v. John Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), and to provide a reason why one having ordinary skill in the pertinent art would have been led to modify the prior art or to combine prior art references to arrive at the claimed invention. See also In re Rouffet, 149 F.3d 1350, 1355, 47 USPQ2d 1453, 1456 (Fed. Cir. 1998). The Examiner must not only identify the elements in the prior art, but also show "some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead the individual to combine the relevant teachings of the references." In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). Such evidence is required in order to establish a prima facie case. In re Piasecki, 745 F.2d 1468, 1471-72, 223 USPQ 785, 787-88 (Fed. Cir. 1984).

Appellants argue that Kohda obtains information for selecting advertisements from users by negotiating with users, who agree to see specific categories of advertisements while browsing (brief, page 5). Appellants further point out that in Kohda, the advertisements are chosen based on information obtained from the filters stored on the user's augmented Web browser and according to the user's specified categories of

advertisement (brief, page 6). To further distinguish the claims over Kohda, Appellants contest the Examiner's characterization of the user's clicking the links as the claimed receiving from an advertiser Web site feedback representing user transactions at the advertiser Web site (brief, page 6; reply brief, page 2).

In response to Appellants' arguments, the Examiner concedes that selecting the advertisement based on the advertiser feedback is indeed missing in Kohda (answer, page 10), and argues that Harvey or Cespedes provide the missing feature (answer, page 11). However, the Examiner's rebuttal requiring Appellants to explain why Kohda's selection of advertisements could not be based at least in part upon advertiser feedback is misplaced. Rather than addressing how the database marketing of Cespedes or Harvey would have suggested selecting advertisements based at least in part upon advertiser feedback, the Examiner asserts that:

> If the advertisers are aware and can tailor their advertisement, there is no apparent reason why the system and method could not be modified to utilize information already obtained by the system/method as set forth under the 103 rejections.
> (Answer, page 19)

It is the Examiner, and not Appellants, who has the initial burden of establishing a prima facie case of obviousness.

Cespedes, specifically in the portions relied on by the Examiner (answer, pages 5 & 6), relates to targeting product

marketing to specific users' needs based on a database of users' credit card purchase information. Although the database marketing of Cespedes selects the advertisements presented to a user based on the available user information in the database, it is not clear exactly what features of Cespedes teach or suggest the selection of advertisements based at least in part upon advertiser feedback. Similarly, the Examiner relies on the high level discussion of advertisement models in Harvey to conclude that adding the specific claimed language regarding the advertiser feedback to Kohda is suggested by Harvey. However, we remain unconvinced that any of these advertisement approaches conclusively establishes the obviousness of modifying Kohda to include the claimed selection of advertisements based at least in part upon advertiser feedback, as recited in claim 85.

Additionally, Appellants argue that the advertisement Kohda selects for display is not from the same plurality of advertisements to which the user responded (brief, page 7; replay brief, page 4). However, we do not find any specific arguments presented by the Examiner to address this limitation or to rebut Appellants' position. As argued by Appellants, there is nothing in Kohda to indicate that the selected advertisements based on the information received from the augmented browser are from the advertisements that led to the user's transaction.

We note that claims 90, 95 and 100 include similar limitations related to the selection of advertisements based at least in part upon advertiser feedback which, as discussed above with respect to claim 85, are absent in the prior art. Accordingly, since the Examiner has failed to meet the burden of providing a prima facie case of obviousness, the 35 U.S.C. § 103 rejection of claims 85-88, 90-93, 95-98 and 100 over Kohda and Cespedes or Harvey cannot be sustained.

With respect to the rejection of the remaining claims, the Examiner further relies on Microsoft Dictionary for using a direct proxy server. However, Microsoft Dictionary does not overcome the deficiencies of Kohda, Cespedes and Harvey, alone or in combination, as discussed above with respect to claim 85. Therefore, we do not sustain the 35 U.S.C. § 103 rejection of claims 89, 94 and 99 over Kohda, Cespedes and Microsoft Dictionary or over Kohda, Harvey and Microsoft Dictionary.

## CONCLUSION

In view of the foregoing, the decision of the Examiner rejecting claims 85-100 under 35 U.S.C. § 103 is reversed.

## REVERSED

ANITA PELLMAN GROSS )
Administrative Patent Judge )
)
)
)
MAHSHID D. SAADAT ) BOARD OF PATENT
Administrative Patent Judge ) APPEALS
) AND
) INTERFERENCES
)
)
ALLEN R. MACDONALD )
Administrative Patent Judge )

MDS/ki

Appeal No. 2004-1828
Application No. 09/094,949

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